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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,684	03/30/2004	Hermann Wurm	85934.000035	4016
23387	7590	09/01/2005	EXAMINER	
Stephen B. Salai, Esq. Harter, Secrest & Emery LLP 1600 Bausch & Lomb Place Rochester, NY 14604-2711			DEUBLE, MARK A	
			ART UNIT	PAPER NUMBER
			3651	

DATE MAILED: 09/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/812,684

Applicant(s)

WURM, HERMANN

Examiner

Mark A. Deuble

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-5 and 7 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,3-5 and 7 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 June 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____

DETAILED ACTION

Response to Amendment

1. The amendment filed June 30, 2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The newly added Figure 7 shows the shape of the dovetailed groove at a level of detail not supported by the original disclosure.

Applicant is required to cancel the new matter in the reply to this Office Action.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1 and 3-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouche (U.S. Patent No. 5,687,858) in view of Bradbury (U.S. Patent No. 4,372,435), as in the office action mailed Marcy 29, 2005.

Bouche shows a storage rack 1 that has a plurality of stacked and spaced tote supports 22 arranged in pairs on opposing sidewalls for supporting platform type totes. A storage and retrieval means for moving the totes into and out of bays in the storage racking is provided by a byway 2 that has a deck 5 with rollers 4 protruding therefrom for shifting the totes into and out of the rack. Thus Bouche shows all the structure required by the claims except for the noise-deadening insert in the tread of the rollers. However, Bradbury teaches that the outer

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circumference of a roller body 20 may have an annular groove 32 formed around the circumference thereof to receive an annular elastomeric insert 30 to ensure smoother conveying of articles over the roller body. The insert may be circular in cross section and fit within a dovetailed groove as illustrated in Fig. 4. The elastomeric insert inherently has noise deadening properties. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the rollers of Bouche with grooves and elastomeric inserts of the type shown in Fig. 4 of Bradbury to ensure smooth movement of the totes into and out of the storage rack. When this is done, the resulting apparatus would have all the structure required by claims 1 and 3-5.

In response to this rejection, applicant's representative argues that there is not suggestion to combine the teachings of Bouche and Bradbury. Specifically, applicant's representative argues that there is no suggestion that Bradbury teaches that the elastomeric inserts insure smoother conveying and there is no suggestion in Bouche that reducing noise is desirable. The examiner respectfully disagrees.

While Bradbury does not state explicitly that the inserts insure "smoother" conveying, it does state, as the applicant's representative points out, that the inserts the inserts "facilitate movement of goods passing along the conveyor." This is precisely what the examiner meant by smoother conveying. The fact that the reference does not use the word "smoother" is irrelevant. The reference clearly teaches that using the inserts is advantageous.

Furthermore, in response to applicant's argument that there is no suggestion in Bouche reducing noise is desirable, it is noted that Bradbury suggests the use of inserts for facilitating movement of goods on a conveyor instead of for reducing noise. However, the fact that

applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

Applicant's representative also argues that even if Bouche and Bradbury are combined, there is no suggestion in Bradbury that the inserts are noise deadening and that Bradbury does not show a groove with a dovetail configuration. The examiner respectfully disagrees.

While it is true that Bradbury does not discuss any noise deadening properties of the inserts, these inserts are elastomeric and they would inherently be noise deadening when rollers 4 of Bouche. Any elastomeric insert on the periphery of a solid roller body would have some noise deadening properties. This fact is pointed out in other prior art, such as Merbler. The fact that this inherent property is not discussed in Bradbury is irrelevant.

Additionally, in regard the argument that the Bradbury does not show a groove with a dovetail configuration, the examiner agrees that the groove illustrated in Fig. 4 of Bradbury does not have a classic dovetail shape, but its shape still fits within a broad reasonable interpretation of the word. As applicant's representative points out, Miriam Webster's Collegiate Dictionary, Eleventh Edition, defines dovetail as "something resembling a doves tail; esp a flaring tenon and mortise into which it fits tightly making an interlocking joint between two pieces (as of wood)." The groove shows in Fig. 4 fits within this definition because the circular groove (the mortise) flares outward from its opening to receive the insert (the tenon) tightly making an interlocking joint between the two pieces. The fact that the reference does not use the word "dovetailed" is irrelevant. If the applicant wishes to use a narrower definition of dovetail, more specific limitations about the shape of the dovetail should be added to the claim. However, as the

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specification of the present application contains no such description of a more detailed shape of any Figure illustrating such a dovetailed shape, it appears that such limitations cannot be added without raising new matter issues. Finally, it should be noted that even if such a narrow definition of the word "dovetail" were adopted, the claims would still be obvious in view of Bouche as modified in view of the teachings of Bradbury because the grooves shown in Bradbury are functionally equivalent to a traditional dovetailed groove.

4. Claims 1, 3-4 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouche (U.S. Patent No. 5,687,858) in view of Merbler (U.S. Patent No. 3,895,844) and further in view of Corkery (U.S. Patent No. 4,682,393).

Bouche shows a storage rack 1 that has a plurality of stacked and spaced tote supports 22 arranged in pairs on opposing sidewalls for supporting platform type totes. A storage and retrieval means for moving the totes into and out of bays in the storage racking is provided by a byway 2 that has a deck 5 with rollers 4 protruding therefrom for shifting the totes into and out of the rack. Thus Bouche shows all the structure required by the claims except for the noise-deadening insert in the tread of the rollers. However, Merbler teaches that the outer circumference of a polyamide roller body 26 (col. 4. ln. 36) may have an annular groove formed around the circumference thereof to receive an annular elastomeric insert 30 to ensure quieter operation of the roller and to facilitate manufacturing of the hub. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the rollers of Bouche with grooved polyamide hubs and elastomeric inserts of the type shown by Merbler to ensure quiet movement of the totes into and out of the storage rack. In regard to the dovetailed configuration of the groove, it should be noted that Corkery teaches that a dovetailed groove

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formed by sidewalls 24, 26, and 28 tightly grips the elastomeric insert forming the contact portion of the roller 4. Therefore it would have been obvious to one of ordinary skill in the art to use a groove having a dovetail configuration in order to tightly grip a roller insert as taught by Merbler. When this is done, the resulting apparatus would have all the structure required by claims 1, 3-4, and 7.

Conclusion

5. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Specifically, claim 7 includes a combination of elements not previously claimed because claim 7 depends from claim 1 which now includes limitations from claims 2 and 6 which claim 7 did not previously depend from. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

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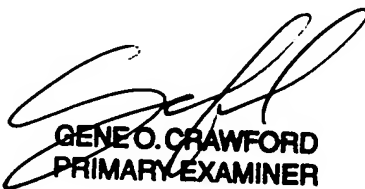
6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark A. Deuble whose telephone number is (571) 272-6912.

The examiner can normally be reached on Monday through Friday except for alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene O. Crawford can be reached on (571) 272-6911. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

md



GENE O. CRAWFORD
PRIMARY EXAMINER